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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,474	02/20/2002	Jorn Leiber	35-224	8423

7590 12/08/2003  
Nixon & Vanderhye  
1100 North Glebe Road  
8th Floor  
Arlington, VA 22201-4714

EXAMINER

KLIMOWICZ, WILLIAM JOSEPH

ART UNIT	PAPER NUMBER
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2652

DATE MAILED: 12/08/2003

7

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/030,474

Applicant(s)

LEIBER ET AL.

Examiner

William J. Klimowicz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 February 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 3.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Information Disclosure Statement***

The information disclosure statement filed February 20, 2002, entitled "Optimem Das Projekt Optimem verfolgt im Wesentlichen drei Ziele" and "Inhaltsverzeichnis CHIP 9/98 No. 99 Pich Klebe fur mehr Gigabyte" have not been considered since they are in a foreign language and since it fails to comply with 37 CFR 1.98(a)(3) because it does not include a concise explanation of the relevance, as it is presently understood by the individual designated in 37 CFR 1.56(c) most knowledgeable about the content of the information, of each patent listed that is not in the English language. It has been placed in the application file, but the information referred to therein has not been considered.

### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Nakayama et al. (US 5,674,583).

As per claim 1, Nakayama et al. (US 5,674,583) discloses a data storage medium (1) having an optical information carrier which comprises a spiral-wound polymer film (2) - see, e.g., FIG. 4(d), wherein the media (1) is spirally wound, the central area of the data storage

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medium (1) being provided with a recess (recess in which cylinder (33) lies) whose periphery is formed by the innermost winding of the polymer film (2).

As per claim 2, the polymer film (2) is wound in a plurality of polymer film plies (located axially) through which information can be read from a preselected polymer film ply and, optionally, written to a preselected polymer film ply (e.g., forming groove (23)).

As per claim 3, there is an adhesion layer between each pair of adjacent polymer film (2) plies (e.g., the layer (28) formed upon polymer substrate (2) is coated thereon and is fixed thereto, such that the interface of layer (28) at the juncture of layer (2) must form an adhesive bond, hence an adhesion layer).

As per claim 4, the refractive index of the adhesion layer differs "only slightly" from the refractive index of the polymer film (2). This is interpreted broadly since the terminology "only slightly" is not defined in the Applicants' specification. Thus, it can be broadly said, that the interface layers of (2) and (28) at their contact point have a refractive index which differs "only slightly" from their respective main layers.

As per claim 5, the refractive index of the polymer film can be changed locally by heating (e.g., via (34)).

As per claim 6, the polymer film (2) is assigned an absorber (28) which is set up at least partly to absorb a write beam (beam forming grooves (23) in layer (28) and to emit the generated heat at least partly, locally, to the polymer film (2). That is, when laser (34) exposes part of film (28), there is at least some radiant heat that must be redirected back into layer (2). No layer, even a transparent layer, is completely unaffected by heat formed by light energy.

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As per claim 7, a process for producing a data storage medium (1) as claimed in claim 1, the polymer film (2) being wound spirally onto a winding body (33) and the winding body (33) subsequently being withdrawn from the central area of the data storage medium (1). It is withdrawn such that the optical tape medium can be used in another device.

As per claim 8, the polymer film (2) being provided on one side with an adhesion layer (interface juncture of (28) and (2) as discussed, *supra*) which faces outward when the polymer film (2) is wound on the winding body (33).

As per claim 9, which depends from claim 1, is drawn to a "data storage medium," *per se*, and as such can be said to be anticipated by Nakayama et al. (US 5,674,583) since there is no positive recitation of a drive which includes at least a reader, that results in a structural difference between the claims and Nakayama et al. (US 5,674,583). As has been widely held in patent law, a recitation of the *intended use* of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

### ***Conclusion***

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

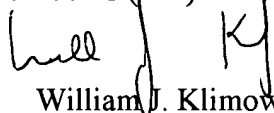
Any inquiry concerning this communication or earlier communications from the examiner should be directed to William J. Klimowicz whose telephone number is (703) 305-

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3452. The examiner can normally be reached on Monday-Thursday (6:30AM-5:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hoa T. Nguyen can be reached on (703) 305-9687. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-4700.

  
William J. Klimowicz  
Primary Examiner  
Art Unit 2652

WJK  
November 30, 2003